

### **REMARKS**

- Claims 1 – 28, 34 – 43 and 47 – 52 are currently pending.
- Of the pending claims, only claims 1, 34, 40 and 47 – 52 are independent.
- Each of the pending independent claims has been amended herein.
- Two dependent claims, claims 53 and 54, have been added herein.
- Claims 47 – 52 have been objected to.
- Claims 1 – 28, 34 – 43 and 47 – 52 stand rejected.
- Claims 18 and 19 have been indicated as allowable.

#### 1. Claim Objections

Claims 47 – 52 have been objected to due to a purported informality. Specifically, it has been asserted that the feature of “determine whether a second rebate has been surrendered” should be replaced with the proposed feature of “determine whether a second rebate has been designated as surrendered.” Applicants respectfully submit that the language of the claim is clear enough for a person of ordinary skill to understand and as such is appropriate. Further, while Applicants appreciate the Examiner’s suggested language, Applicants respectfully submit that the language proposed by the Examiner would be unduly restrictive. “Determin[ing] whether a second rebate has been designated as surrendered” (the language proposed by the Examiner) is but one manner of determining whether a second rebate has been surrendered. The language of the claim as currently pending encompasses various other manners of determining whether a second rebate has been surrendered. As just a couple of examples, the claims as currently pending would cover: (i) determining whether a second rebate has been surrendered by querying an employee; and (ii) determining whether a second

rebate has been surrendered by determining whether a particular document has been received from a customer or another predetermined event has occurred. It is not clear whether the Examiner's proposed language would encompass such exemplary manners.

Further, Applicants did not use the language "designated as surrendered" in the specification, and thus are hesitant to use the terminology.

In summary, Applicants respectfully note that the current language of the claim is sufficiently clear for a person of ordinary skill in the art to understand what would constitute infringement yet is broad enough to encompass a myriad of manners of determining whether a second rebate has been surrendered. Applicants can see no need to possibly narrow the scope of the claim by adopting the proposed language. It appears to Applicants that the Examiner's objection is substantially similar to a §112, second paragraph rejection. As such, Applicants respectfully note that "[t]he examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." MPEP 2173.02. Further, as the objection also appears to be a concern that the claim language is unduly broad, Applicants respectfully note that "Breadth of a claim is not to be equated with indefiniteness." MPEP 2173.04.

For all of the above reasons, Applicants respectfully request that the objection to claims 47 – 52 be withdrawn.

## 2. Section 103 Rejections

Claims 1 – 5, 28, 34, 35, 38 and 47 – 50 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the article entitled "Quaker State Reacts Quickly to Sears Bottle", published in the Oil Daily on April 01, 1982 and written

by Moore ("Moore" herein) in view of U.S. Patent No. 5,905,246 to Fajkowski ("Fajkowski" herein).

Claims 6, 16, 17, 20, 39 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Fajkowski and further in view of U.S. Patent No. 5,200,889 ("Mori" herein).

Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Fajkowski and Mori and further in view of the article entitled "Loyalty: Check It Out", published on July 08, 1994 in the LA Times ("LA Times" herein).

Claims 12, 13, 36 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Fajkowski and further in view of U.S. Patent No. 5,901,303 to Chew ("Chew" herein).

Claims 14, 15 and 21 – 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Fajkowski, Chew and LA Times.

Claims 7 – 10, 41 – 43, 51 and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moore in view of Fajkowski and Mori.

Although Applicants respectfully disagree with the Examiner's interpretations of the references for the reasons stated in the response to the previous Office Action, Applicants have amended each of the pending independent claims to further distinguish over the references. Applicants have amended the claims solely to expedite allowance of the pending claims and to claim particular embodiments of the present invention. Applicants reserve the right to pursue the subject matter of the claims as pending prior to the amendments made herein in a continuing application.

Applicants have amended each of the pending independent claims to recite the following general feature that is not taught or suggested by any of the references of record, alone or in combination:

*a first rebate redeemable for a first value and a second rebate redeemable for a second value that is different from the first value, wherein the second rebate is offered to a consumer in exchange for the first rebate or otherwise wherein the consumer can only obtain one of the first rebate or the second rebate*

For example, while Mori discloses a system in which a customer may accumulate values of a plurality of rebates, the rebate values are accumulated (i.e., added together) such that the customer does not choose among one of a first rebate and a second rebate but rather is allowed to redeem each of the rebates.

Similarly, none of Fajkowski, LA Times, Chew or Moore teach or disclose a first rebate redeemable for a first value, a second rebate redeemable for a second value, wherein a consumer may only redeem one of the two rebates.

#### Claims 18 and 19

Claims **18 and 19** stand as allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §§101 and 112 and to include all of the limitations of the base claim and any intervening claims. Current Office Action, page 14, paragraph 6.

Applicants acknowledge the indication of the allowability of claims **18 and 19**. Applicants have refrained from amending these claims at this time, pending reconsideration of the remainder of the pending claims.

### Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461 - 7041 or via electronic mail at [mfincham@walkerdigital.com](mailto:mfincham@walkerdigital.com).

### Petition for Extension of Time to Respond

Applicants do not believe an extension of time is required with this response. However, if an extension of time should be due, Applicants hereby petition for such extension of time with which to respond to the Office Action. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

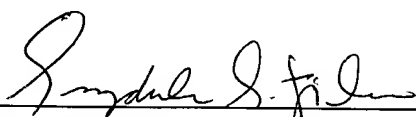
If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Charge any additional fees or credit any overpayment to the same account.

*A duplicate copy of this authorization is enclosed for such purposes.*

Respectfully submitted,

January 10, 2005  
Date

  
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